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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael R. Kluth

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EXAMINER

CALDWELL, ANDREW T

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,143

Applicant(s)

KLUTH, MICHAEL R.

Examiner

Andrew Caldwell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,7,9-14,21-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,9-14,21-25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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**Remarks**

This Office action is mailed in response to the Office letter mailed August 29, 2005 withdrawing this application from issue. Prosecution on the merits of this application is reopened on all pending claims. They are considered unpatentable for the reasons indicated below.

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4 and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 4 and 7 are directed to software that is not tangibly embodied in a computer readable medium.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 7, 9, 11-14, 21-24, and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Mathurin, U.S. Patent No. 6,941,181.

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1  
2       Regarding claim 1, Mathurin anticipates the claimed invention by disclosing a  
3 system comprising:

4           A processor (Fig. 6 elem. 78);

5           A memory operably coupled to the processor (Fig. 3 elem. 20);

6           A case housing the processor and memory and defining a recess, the  
7 recess configured to receive an input device (Fig. 3 elem. 52 as casing);

8           An input device having a processor and a touch screen, the input device  
9 configured to removably assemble in the recess, the touch screen operable to  
10 receive user inputs, the user inputs communicated to the computer system  
11 processor and memory when the input device is assembled in the recess and  
12 communicated to the input device processor and memory when the input device  
13 is removed from the recess (Fig. 3 elem. 50 portable section as input device; Fig.  
14 3 elem. 12 as touchscreen);

15           A computer program stored in the computer system memory associated  
16 with the computer comprising:

17           A set of instructions to provide a first decision, wherein the first  
18 decision permits data stored in the memory of the input device to be  
19 transmitted to the memory of the computer system (col. 11 lines 3-23 user  
20 records from memory card/slot Fig. 3 elem. 64 to CD Fig. 3 elem. 20);

21           A set of instructions configured to provide a second decision,  
22 wherein the second decision permits synchronization of data between the

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memory of a computer system and a memory of the input device (col. 11 lines 3-23 user records from memory card/slot Fig. 3 elem. 64 to CD Fig. 3 elem. 20).

Regarding claim 4, it is directed to the computer program of claim 1. Since the remarks given above with respect to claim 1 apply equally to claim 4, separate reasons for rejection are not required.

Regarding claim 7, Mathurin teaches a computer program product further comprising a set of instructions configured to synchronize data stored in the memory of the computer system with data stored in the memory of the input device upon insertion of the input device into the computer system (col. 11 lines 3-23).

Regarding claim 9, it is directed to a method of operating the system of claim 1. Since the remarks given above with respect to claim 1 apply equally to claim 9, separate reasons for rejection are not required.

Regarding claim 11, Mathurin teaches a method wherein inserting the input device into the computer system housing operably couples the memory of the computer system to the memory of the input device (col. 11 lines 3-23).

Regarding claim 12, Mathurin teaches a method further comprising initiating synchronization of data stored in the memory of the computer system and data stored in the memory of the input device upon the connecting of the input device to the computer system (col. 11 lines 3-23).

Regarding claim 13, Mathurin teaches a method wherein the input device further comprises a touch screen (Fig. 3 elem.12).

1        Regarding claim 14, Mathurin teaches a method further comprising entering a  
2        command onto the touch screen of the input device, wherein the command is  
3        communicated from the touch screen of the input device to the computer system for  
4        execution by the computer system (col. 11 lines 3-23).

5        Regarding claims 21-22, they are apparatus claims directed to the input device of  
6        claim 1. Since the reasons for rejection given above with respect to claim 1 apply  
7        equally to claims 21-22, separate reasons for rejection are not necessary.

8        Regarding claim 23, Mathurin teaches an input device further comprising an  
9        amplitude modulated radio receiver (Fig. 6 elem. 86).

10       Regarding claim 24, Mathurin teaches an input device further comprising an  
11       frequency modulated radio receiver (Fig. 6 elem. 86).

12       Regarding claim 29, Mathurin teaches a system wherein the memory of the input  
13       device is configured to store data in an audio format (col. 11 lines 3-23).

14       Regarding claim 30, Mathurin teaches a method wherein inserting the input  
15       device into the recess of the computer system operably couples the memory of the  
16       computer system to the memory of the input device (col. 11 lines 3-23).

17       Regarding claim 31, Mathurin teaches a method wherein the input device  
18       receives data from the computer system over the Internet (col. 9 lines 64-67).

19       Regarding claim 32, Mathurin teaches a method wherein the input device  
20       receives data from the computer system over a wireless network (Fig. 6 elem. 86).

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1        Claims 1, 4, 7, 9-14, 21-25, and 27-32 are rejected under 35 U.S.C. 102(e) as  
2        being anticipated by Dickie, U.S. Patent App. Pub. 2003/0041206.

3  
4        Regarding claim 1, Dickie anticipates the claimed invention by disclosing a  
5        system comprising:

6            A processor (Fig. 4);

7            A memory operably coupled to the processor (Fig. 4);

8            A case housing the processor and memory and defining a recess, the  
9        recess configured to receive an input device (Fig. 4);

10          An input device having a processor and a touch screen, the input device  
11        configured to removably assemble in the recess, the touch screen operable to  
12        receive user inputs, the user inputs communicated to the computer system  
13        processor and memory when the input device is assembled in the recess and  
14        communicated to the input device processor and memory when the input device  
15        is removed from the recess (Fig. 1 elem. 102 as input device; Fig. 3 elem. 204 as  
16        touchscreen);

17          A computer program stored in the computer system memory associated  
18        with the computer comprising:

19            A set of instructions to provide a first decision, wherein the first  
20        decision permits data stored in the memory of the input device to be  
21        transmitted to the memory of the computer system (pars. 26-28);

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1                   A set of instructions configured to provide a second decision,  
2                   wherein the second decision permits synchronization of data between the  
3                   memory of a computer system and a memory of the input device (pars.  
4                   26-28).

5           Regarding claim 4, it is directed to the computer program of claim 1. Since the  
6   remarks given above with respect to claim 1 apply equally to claim 4, separate reasons  
7   for rejection are not required.

8           Regarding claim 7, Dickie teaches a computer program product further  
9   comprising a set of instructions configured to synchronize data stored in the memory of  
10   the computer system with data stored in the memory of the input device upon insertion  
11   of the input device into the computer system (pars. 26-28).

12          Regarding claim 9, it is directed to a method of operating the system of claim 1.  
13   Since the remarks given above with respect to claim 1 apply equally to claim 9,  
14   separate reasons for rejection are not required.

15          Regarding claim 10, Dickie teaches an input device further comprising a digital  
16   pager (par. 3).

17          Regarding claim 11, Dickie teaches a method wherein inserting the input device  
18   into the computer system housing operably couples the memory of the computer  
19   system to the memory of the input device (pars. 26-28).

20          Regarding claim 12, Dickie teaches a method further comprising initiating  
21   synchronization of data stored in the memory of the computer system and data stored in



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1 the memory of the input device upon the connecting of the input device to the computer  
2 system (pars. 26-28).

3 Regarding claim 13, Dickie teaches a method wherein the input device further  
4 comprises a touch screen (Fig. 4 elem.204).

5 Regarding claim 14, Dickie teaches a method further comprising entering a  
6 command onto the touch screen of the input device, wherein the command is  
7 communicated from the touch screen of the input device to the computer system for  
8 execution by the computer system (pars. 26-28).

9 Regarding claims 21-22, they are apparatus claims directed to the input device of  
10 claim 1. Since the reasons for rejection given above with respect to claim 1 apply  
11 equally to claims 21-22, separate reasons for rejection are not necessary.

12 Regarding claim 23, Dickie teaches an input device further comprising an  
13 amplitude modulated radio receiver (par. 3).

14 Regarding claim 24, Dickie teaches an input device further comprising an  
15 frequency modulated radio receiver (par. 3).

16 Regarding claim 25, Dickie teaches an input device further comprising a digital  
17 pager (par. 3).

18 Regarding claim 27, Dickie teaches an input device further comprising a point  
19 stick (Fig. 4 elem. 206; par. 25).

20 Regarding claim 28, Dickie teaches an input device wherein the input device is a  
21 PDA (Fig. 1 elem. 102).

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Regarding claim 29, Dickie teaches a system wherein the memory of the input device is configured to store data in an audio format (pars. 2-4).

Regarding claim 30, Dickie teaches a method wherein inserting the input device into the recess of the computer system operably couples the memory of the computer system to the memory of the input device (pars. 26-27).

Regarding claim 31, Dickie teaches a method wherein the input device receives data from the computer system over the Internet (par. 3).

Regarding claim 32, Dickie teaches a method wherein the input device receives data from the computer system over a wireless network (par. 20).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Caldwell, whose telephone number is (571) 272-3868. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m. EST.

The fax number for Group 2100 is as follows:

Fax Responses: 571-273-8300

Any general inquiry relating to the status of this application can be answered using Patent Application Information Retrieval (PAIR) system, which is available at the USPTO web site. Any questions on using the PAIR system should be directed to the Patent Electronic Business Center toll free at (866) 217-9197.



Andrew Caldwell  
571-272-3868  
October 10, 2005

**ANDREW CALDWELL**  
**SUPERVISORY PATENT EXAMINER**